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MORGAN, LEWIS & BOCKIUS LLP
1701 MARKET STREET
PHILADELPHIA, PA 19103-2921

EXAMINER
SUBRAMANIAN, NARAYANSWAMY

ART UNIT	PAPER NUMBER
3628	

DATE MAILED: 09/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>24 July 2006</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1,4-7 and 26</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1,4-7 and 26</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)	4)☐ Interview Summary (PTO-413)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)	5)☐ Notice of Informal Patent Application (PTO-152)
Paper No(s)/Mail Date _____.	6)☐ Other: _____.

DETAILED ACTION

1.   This office action is in response to applicants' request for continued examination filed on

July 24, 2006. Amendments to claims 1 and 26 and cancellation of claim 27 have been entered.

Claim 26 has been reinstated in view of applicant's persuasive arguments. Claims 1, 4-7 and 26

are pending in the application and have been examined. The rejections and response to

arguments are stated below.

Claim Rejections - 35 USC § 112

2.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
> subject matter, which the applicant regards as his invention.

3.   Claims 1, 4-7 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

Claims 1 and 26 recite in the preamble the limitation "A computer-implemented method

to trade objects". However it is not clear as to which steps of the method are performed by the

computer. Also it is not clear as to in which step of the claim the trading actually takes place.

Appropriate correction/clarification is required. Claims 1 and 26 also recite the limitation

"encoding user-preferences associated with an order". However it is not clear how this encoding

is used in the remaining steps of the claim. Claim 1 also recites the limitation "one or more sell

orders identified in the searching step". There is no antecedent basis for this limitation because the

step of "identifying one or more sell orders" has not been positively recited. Similarly claim 26

recites the limitation "one or more buy orders identified in the searching step". There is no

antecedent basis for this limitation because the step of "identifying one or more buy orders" has not

been positively recited. Claims 1 and 26 also recite the limitation "attempting to match". It is not

clear as to what the applicant means by the phrase "attempting to match". The metes and bounds of

this limitation are not clear. Claims 4-7 are rejected by way of dependency on claim 1.

The art rejections given below are interpreted in the light of 35 USC § 112, second

paragraph rejections made above.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

5.   Claims 1, 4-7 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Sundaresan et al (US Patent 6,868,400 B1) in view of Walsh et al (US Patent 6,144,848) and

further in view of Kuechler et al (US Patent 5,237,678).

Claim 1, Sundaresan teaches a computer-implemented method to trade objects over a

network, comprising: receiving a buy order from a user for an object having at least four

dimensions associated with said object (See Sundaresan Column 2 lines 60-63 and Column 7

lines 25-30); encoding user-preferences associated with at least one of the buy order or one of a

plurality of sell orders (See Sundaresan Column 9 line 57 – Column 10 line 21); applying

characteristics of one or more sell orders identified in a searching step and the user preferences, to

a quality function that outputs one or more quality values for the one or more sell orders identified

in the searching step to the user (See Sundaresan Column 6 lines 9-14); and attempting to match

said buy order with one or more sell orders identified in the searching step in accordance with said

one or more quality values (See Sundaresan Column 6 line 60 – Column 7 line 40). The spread

function is interpreted to include the quality function and the spread value is interpreted to

include a quality value. The limitation "a filter specified by the user that creates an arbitrarily-

shaped region within the at least four dimensions" is not a positive recitation of the creation of

arbitrarily-shaped region within the at least four dimensions and hence is not given patentable

weight. Similarly the limitation "in order to identify one or more sell orders that are within said

arbitrarily-shaped region, wherein said searching of said indexing tree only identifies one or more

sell orders that are within said arbitrarily-shaped region" is interpreted as an intended use of the

searching step and hence is not given patentable weight.

Sundaresan does not explicitly teach the steps wherein the buy order includes a filter

specified by the user; searching in accordance with the filter specified by the user, an indexing tree

that includes the plurality of sell orders for objects having said at least four dimensions; receiving a

message to modify said buy order while said buy order is pending, wherein said message is

received from a party associated with the buy order and modifying said buy order in accordance

with said message.

Walsh teaches the steps of receiving a message to modify an order while said order is

pending, wherein said message is received from a party associated with the order and modifying

said order in accordance with said message (See Walsh Column 7 lines 55-65, Column 21 lines 10-

19 and Column 28 lines 24-39).

Both Sundaresan and Walsh are concerned with the problem of facilitating trade between

buyers and sellers. It would have been obvious to one with ordinary skill in the art at the time of

invention modify Sundaresan to include steps taught by Walsh. The combination of the disclosures

taken as a whole suggests that it would have helped a users make changes to their order as new

information becomes available to them.

Sundaresan does not explicitly teach the step wherein the buy order includes a filter

specified by the user and searching in accordance with the filter specified by the user, an indexing

tree that includes the plurality of sell orders for objects having said at least four dimensions.

Kuechler teaches the step wherein the records include a filter specified by the user within a

region having at least four dimensions and searching for records that meet that criteria within that

region (See Kuechler Column 1 lines 44-52, Column 24 line 63 – Column 25 line 5 and claim 1,

the B-tree is interpreted to include the indexing tree and the records are interpreted to include buy

and sell orders).

Both Sundaresan and Kuechler are concerned with matching records that meet certain

criteria. It would have been obvious to one with ordinary skill in the art at the time of invention

modify Sundaresan to include steps taught by Kuechler. The combination of the disclosures taken

as a whole suggests that it would have helped in the efficient retrieval, manipulation, and analysis

of stored information in an information base (See Kuechler Column 1 lines 11-15).

Claims 4-6, Sundaresan teaches a method of claim 1 as discussed above including the

step wherein said object is at least one of a group comprising goods and services (See Sundaresan

abstract).

Sundaresan does not explicitly teach the steps wherein said object is a vehicle and

wherein said at least four dimensions for said vehicle comprises at least four dimensions from a

group of dimensions comprising manufacturer, model, year, mileage, color, and accessories.

Official notice is taken these steps are old and well known in the art. For instance a buyer

interested in buying a vehicle would generally express the desired features in the vehicle that

he/she is interested in buying. These features help a car buyer find the right car according to his/her

needs and preferences.

It would have been obvious to one of ordinary skill in the art at the time of invention to

include these steps to the invention of Sundaresan. The combination of disclosures suggests taken

as a whole suggests that it would have helped a car buyer find the right car according to his/her

needs and preferences.

Claim 7, Walsh teaches the steps of receiving a message to execute said buy order and

automatically executing said buy order in accordance with said message (See Walsh Column 21

lines 10-19).

Claim 26, Sundaresan teaches a computer-implemented method to trade objects over a

network, comprising: receiving a sell order from a user for an object having at least four

dimensions associated with said object (See Sundaresan Column 2 lines 60-63 and Column 7

lines 25-30); encoding user-preferences associated with at least one of the sell order or one of a

plurality of buy orders (See Sundaresan Column 9 line 57 – Column 10 line 21); applying

characteristics of one or more buy orders identified in a searching step and the user preferences, to

a quality function that outputs one or more quality values for the one or more buy orders identified

in the searching step to the user (See Sundaresan Column 6 lines 9-14); and attempting to match

said sell order with one or more buy orders identified in the searching step in accordance with said

one or more quality values (See Sundaresan Column 6 line 60 – Column 7 line 40). The spread

function is interpreted to include the quality function and the spread value is interpreted to

include a quality value. The limitation "a filter specified by the user that creates an arbitrarily-shaped region within the at least four dimensions" is not a positive recitation of the creation of arbitrarily-shaped region within the at least four dimensions and hence is not given patentable weight. Similarly the limitation "in order to identify one or more buy orders that are within said arbitrarily-shaped region, wherein said searching of said indexing tree only identifies one or more buy orders that are within said arbitrarily-shaped region" is interpreted as an intended use of the searching step and hence is not given patentable weight. Sundaresan's invention apply equally to buyer looking for sellers and a seller looking for buyers (See Sundaresan Column 15 line 27 – Column 17 line 20).

Sundaresan does not explicitly teach the steps wherein the sell order includes a filter specified by the user; searching in accordance with the filter specified by the user, an indexing tree that includes the plurality of buy orders for objects having said at least four dimensions; receiving a message to modify said sell order while said sell order is pending, wherein said message is received from a party associated with the sell order and modifying said sell order in accordance with said message.

Walsh teaches the steps of receiving a message to modify an order while said order is pending, wherein said message is received from a party associated with the order and modifying said order in accordance with said message (See Walsh Column 7 lines 55-65, Column 21 lines 10-19 and Column 28 lines 24-39).

Both Sundaresan and Walsh are concerned with the problem of facilitating trade between buyers and sellers. It would have been obvious to one with ordinary skill in the art at the time of invention modify Sundaresan to include steps taught by Walsh. The combination of the disclosures

taken as a whole suggests that it would have helped a users make changes to their order as new

information becomes available to them.

Sundaresan does not explicitly teach the step wherein the sell order includes a filter

specified by the user and searching in accordance with the filter specified by the user, an indexing

tree that includes the plurality of buy orders for objects having said at least four dimensions.

Kuechler teaches the step wherein the records include a filter specified by the user within a

region having at least four dimensions and searching for records that meet that criteria within that

region (See Kuechler Column 1 lines 44-52, Column 24 line 63 – Column 25 line 5 and claim 1,

the B-tree is interpreted to include the indexing tree and the records are interpreted to include buy

and sell orders).

Both Sundaresan and Kuechler are concerned with matching records that meet certain

criteria. It would have been obvious to one with ordinary skill in the art at the time of invention

modify Sundaresan to include steps taught by Kuechler. The combination of the disclosures taken

as a whole suggests that it would have helped in the efficient retrieval, manipulation, and analysis

of stored information in an information base (See Kuechler Column 1 lines 11-15).

Response to Arguments

6.   In response to applicant's argument that there is no suggestion to combine the references,

the examiner recognizes that obviousness can only be established by combining or modifying the

teachings of the prior art to produce the claimed invention where there is some teaching,

suggestion, or motivation to do so found either in the references themselves or in the knowledge

generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5

USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir.

1992). In this case, both Sundaresan and Kuechler are concerned with matching records that meet

certain criteria. It would have been obvious to one with ordinary skill in the art at the time of

invention modify Sundaresan to include steps taught by Kuechler. The combination of the

disclosures taken as a whole suggests that it would have helped in the efficient retrieval,

manipulation, and analysis of stored information in an information base (See Kuechler Column 1

lines 11-15).

Applicant's other arguments with respect to pending claims have been considered but are

not persuasive in view of the 35 USC § 112, second paragraph rejections above.

Conclusion

7.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is

(571) 272-6751. The examiner can normally be reached Monday-Thursday from 8:30 AM to

7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Hyung Sub Sough can be reached at (571) 272-6799. The fax number for Formal or

Official faxes and Draft to the Patent Office is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PMR or Public PAIR. Status information for unpublished

applications is available through Private PMR only. For more information about the PMR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit: 3628

Dr. N. Subramanian

September 15, 2006